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| 10/621,653 | 07/16/2003 | Robert L. Wilson | 989-P-1 | 1045 |

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EXAMINER

ELKINS, GARY E

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,653

Applicant(s)

WILSON ET AL.

Examiner

Gary E. Elkins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20031107</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-7 in the reply filed on 21 October 2004 is acknowledged. The traversal is on the ground(s) that the differences between the product and method claims are not material since (1) the rack structure is the same whether or not the rack is installed at the factory or not and (2) the step of removing the sissy bar would not have to be practiced but in other aspects, the procedure is the same, i.e. the product, as claimed, whether installed at the factory or as an after market item uses essentially the same installation process.

This is not found persuasive because claim 8 clearly requires the steps of replacing an existing sissy bar and the product of claims 1-7 can clearly be used in another and materially different process as set forth in the restriction requirement. It is believed that claim 8 could not be met by a reference evidencing a method of attaching the rack at the factory. As such, the alternative method of attaching the rack set forth in the requirement is believed to be materially different. The assertion that the steps of replacing a sissy bar would not have to be practiced is unclear insofar as claim 8 specifically requires these steps as limitations of the method and the claim cannot be met without meeting these limitations.

The requirement is still deemed proper and is therefore made FINAL.

2. Claim 8 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 21 October 2004.

Claim Rejections - 35 USC § 112

3. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 2, "like side" is unclear in meaning. What side is "like side"?

The following each lack antecedent basis in the claims, i.e. each is only inferentially set forth: claim 1, lines 2 and 6, "the rear fender" and "the bores in the mounting plates", and claim 3, "the sissy bar" (two occurrences).

In claim 1, part (b), it is unclear how a single flange has bores adapted to align with the bores in a plurality of mounting plates at opposite sides of the motorcycle, i.e. it would appear that a plurality of flanges would be necessary to a plurality of mounting plates.

In claim 1, part (c), "each said body" is unclear insofar as only one body was previously defined in the claim.

In claim 1, part (c), "having defining" is unclear grammatically, i.e. having *and* defining would appear to be the intended meaning.

In claim 1, parts (d) and (e), the word "means" is preceded by the word(s) "fastener" and "stop" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). Also, the function of the "fastener means" as defined by the "whereby" clause is unclear. As such, the scope of the means plus function, pursuant to 35 USC 112, sixth paragraph, is unclear.

In claim 1, lines 13 and 16, "the bracket" in each line is unclear insofar as a plurality of brackets were previously defined in the claim, i.e. which of the plurality is being referred to?

In claim 6, line 1, "said bracket body location" is unclear insofar as a plurality of bracket body locations were previously defined.

In claim 6, it is unclear how a single location defining a single slot can receive the lower end of a plurality of legs, i.e. it would appear that a plurality of locations would be required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by McCann.

McCann discloses a rack 52 including a generally U-shaped frame with opposite legs 56, 58, a pair of mounting brackets 24 having a flange formed at the lower portion of each bracket and including bores 26, 28 for mounting each bracket to a motorcycle. As best understood in view of paragraph 3 above, the rack includes "fastener means" 34 and "stop means" 42, 44, 46. With respect to claim 7, "retainer means" 76 retains the rack in the substantially horizontal or substantially vertical position. It is noted that no distinction is seen between the rack claimed and that of McCann as a result of the claimed intended use of the rack to hold luggage or the claimed intended use of the mounting bracket flanges to align with the bores in mounting plates on a motorcycle, i.e. the rack of McCann is considered capable of holding luggage in the

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substantially horizontal position and the bracket flanges are considered capable of aligning with bores in mounting plates on a motorcycle.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCann in view of Willey. McCann discloses all structure of the claimed rack except formation of the frame from chrome plated steel (cl. 2), a plate extending between opposite legs of the frame (cl. 4), or a plate between the opposite legs carrying indicia. Willey teaches that it is known to make the frame elements on a motorcycle rack from chrome plated steel to enhance the appearance of the rack. Willey also teaches that it is known to provide a decorative plate (34) secured between the legs of a rack. With respect to claim 2, it would have been obvious to make the frame in McCann from chrome plated steel as taught by Willey to provide a strong frame that also enhances the appearance of the rack. With respect to claim 4, it would have been obvious to make the rack of McCann with a decorative plate as taught by Willey to enhance the appearance of the rack in the generally vertical position. With respect to claim 5, it would have been obvious to make the decorative plate in modified McCann with decorative indicia as a mere change in the appearance of the plate. No functional distinction is seen between the decorative plate as taught by Willey and that claimed nor has any functional distinction been asserted by

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Applicant. A mere change in the appearance of a device is not patentable in a utility application. Design applications are available for patenting differences solely in the appearance of a device.

Allowable Subject Matter

8. Claims 3 and 6, as best understood in view of paragraph 3 above, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

The remaining cited prior art is illustrative of the general state of the art.

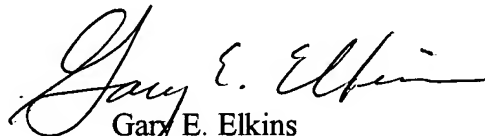
In order to reduce pendency and avoid potential delays, Technology Center 3700 is encouraging FAXing of responses in Office Actions to (703)872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by Applicants who authorize charges to a PTO deposit account. Please identify the Examiner and art unit at the top of your cover sheet.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. Also, copies of an office action or other file information may be obtained from the Private PAIR system. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions regarding access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Any inquiry concerning this communication or earlier communication from the Examiner should be directed to Gary Elkins at telephone number (571)272-4537. The Examiner can normally be reached Monday, Wednesday and Thursday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Lee Young can be reached at (571)272-4549.


Gary E. Elkins
Primary Examiner
Art Unit 3727

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04 January 2005